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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,869	04/16/2004	Ricardo Alexander Gomez	001087	9828

7590 09/30/2005

Allan Chan & Associates  
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New York, NY 10005

EXAMINER
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FLANAGAN, BEVERLY MEINDL

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/826,869

Applicant(s)

GOMEZ, RICARDO ALEXANDER

Examiner

Beverly M. Flanagan

Art Unit

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
BEVERLY M. FLANAGAN  
PRIMARY EXAMINER

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement filed April 16, 2004 has been made of record and the references cited therein have been considered by the examiner.

### ***Claim Objections***

Claims 14, 25 and 37 are objected to because of the following informalities: The claim fails to end with proper punctuation. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7, 16, 18, 39 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 7 and 18, the housing and sheath have not been previously recited in independent claims 1 and 16, from which claims 7 and 18 depend, respectively, as separate elements. In claim 1, the housing is recited as forming a sheath.

In claims 1, 16, 27 and 39, the phrase "the instrument" or "the inserted instrument" lacks proper antecedent basis in the claim. In claim 40, the phrase "the protective apparatus" lacks proper antecedent basis in the claim.

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***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 16-39 rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-15 of the instant application. This is a double patenting rejection.

As for the independent claims, claim 1 is identical to claim 27. Claim 1 and 16 differ only in that claim 1 recites "the instrument" and claim 16 recites "the inserted instrument." Claim 1 and claim 39 differ only in that claim 1 recites "the instrument" and claim 39 recites "the inserted instrument to be used during a medical procedure." As for the dependent claims, all dependent claims falling under each independent claim are identical.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 10-12, 16-18, 21-23 27-29, 32-35, 39 and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Rogers, Jr. (U.S. Patent Application Publication No. 2004/0188302).

**In regard to claims 1-6, 16, 17, 21, 22, 27, 28, 32-34 and 39, Rogers, Jr.** teaches a kit 7 that includes a primary pouch 1, a secondary pouch 2, inflatable pouch 3 for shipment and transport of an endoscope (see Figure 1). The inflatable pouch 3 is preferably sized such that it can be used with common cases provided with new endoscopic equipment, such as case 8 comprised of a hard outer case 81 and handle 82 (see Figure 6 and page 4, section 0037). A foam insert is usually located within the case 8 for keeping the medical device in position and for preventing shock or vibration from causing harm to the enclosed medical device (see page 4, section 0043). **In regard to claims 7, 18, 29 and 35,** the cavity formed between the secondary pouch 2 and case 8 is filled with inflatable pouch 3, that contains air, which is an impact absorbing material and both a liquid and a gas. **In regard to claims 12 and 23,** as broadly as claimed, the case 8 can be removably affixed to any surface. **In regard to claim 40,** see page 5, sections 0051 to 0055.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-15, 24-26 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers, Jr. (U.S. Patent Application Publication No. 2004/0188302).

**In regard to claims 13-15, 24-26 and 36-38**, Rogers, Jr. teaches a handle 82 on the case 8. However, it would have been obvious for one of ordinary skill in the art to utilize art-recognized equivalent structures to the handle 82, such as an anchor and cord, for transporting the case 8. Similarly, the separation of elements, where removability would be desirable, is a design consideration within the skill of the art. In re Dulberg, 283 F.2d 522, 129 USPQ 348 (CCPA 1961). Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make and handle structure used in the device of Rogers, Jr. removable.

Claims 8, 19 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers, Jr. (U.S. Patent Application Publication No. 2004/0188302) in view of Dohm et al. (U.S. Patent No. 5,720,391).

**In regard to claims 8, 19 and 30**, Rogers, Jr. teaches an inflatable pouch 3 for absorbing impact. However, Dohm et al. teach a similar transportation case for a medical instrument having a spacer 212 made of shock absorbing material, such as a styrofoam material (see col. 5, lines 64-66). Dohm et al. thus demonstrate that the use of styrofoam materials for cushioning a medical device during transport are well known in the art. Accordingly, it would have been obvious for one of ordinary skill in the art at

the time the invention was made to utilize Styrofoam between the secondary pouch 2 and the case 8 in Rogers, Jr. as an alternate means for cushioning the endoscope 5.

Claims 9, 20 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers, Jr. (U.S. Patent Application Publication No. 2004/0188302) in view of Lantz (U.S. Patent No. 6,910,582).

**In regard to claims 9, 20 and 31**, Rogers, Jr. teaches an inflatable pouch 3 for absorbing impact. However, Lantz teaches a similar transportation case having a gel pack 40 for cushioning (see col. 5, lines 55-65). Lantz thus demonstrates that the use of gel materials for cushioning is well known in the art. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to utilize gel packs between the secondary pouch 2 and the case 8 in Rogers, Jr. as an alternate means for cushioning the endoscope 5.

### ***Conclusion***

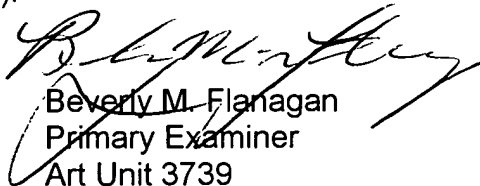
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant should note the following prior art references disclosing transportation cases for endoscopes: Parker, U.S. Patent No. 6,749,063; Monch, U.S. Patent No. 4,730,729; Strom et al., U.S. Patent No. 5,323,899; Hasegawa et al., U.S. Patent No. 6,846,285; Costello et al., U.S. Patent No. 6,066,089; Ciarlei, U.S. Patent No. 5,314,070; Jackson, U.S. Patent No. 4,256,225 and Rabiner et al., U.S. Patent No. 6,527,115.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beverly M. Flanagan whose telephone number is (571) 272-4766. The examiner can normally be reached on Mondays, Tuesdays and Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Beverly M. Flanagan  
Primary Examiner  
Art Unit 3739

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